

ARGUMENTS

Claims 1-20 are under examination in this application. The Office Action mailed on March 18, 2008, includes the following rejections:

1. Claims 15, 11-14 and 16 are rejected under 35 U.S.C. § 112.
2. Claims 1, 2, 11-12, 14 and 16 are rejected under 35 U.S.C. § 103 as being unpatentable.
3. Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable.
4. Claims 4 and 7-9 are rejected under 35 U.S.C. § 103 as being unpatentable.
5. Claims 5-6 are rejected under 35 U.S.C. § 103 as being unpatentable.
6. Claim 10 is rejected under 35 U.S.C. § 103 as being unpatentable.
7. Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable.
8. Claims 17-19 are rejected under 35 U.S.C. § 103 as being unpatentable.
9. Claim 20 is rejected under 35 U.S.C. § 103 as being unpatentable.

The claims have been amended and over come all objections. The amendments to the claims are fully supported by the specification as originally filed, specifically claims 1-20 and paragraph [0030] of the specification, and as such do not introduce new matter.

Finality of the Action

Applicant requests reconsideration of the finality of the rejection of the last Office action, and that the finality of that action be withdrawn. The Action presents entirely new reference combinations and new grounds for rejection for many of the claims, which the Applicant has not been allowed to address.

For example, Recker et al. (U.S Patent No. 6,523,768) was cited ONLY against claim 10 in the Office Action mailed August 17, 2007; however, it is cited against all claims in the present Office Action. Applicant merely seeks to define further his invention and expedite prosecution of the Application and seeks the cooperation of the Examiner to that end, and respectfully request that prosecution of his Application not be prematurely cut off. Applicant respectfully request that the finality of the rejection be withdrawn.

Claims 1-5, 11-14 and 16 are rejected under 35 U.S.C. § 112

The Action rejects claims 1-5, 11-14 and 16 under 35 U.S.C. § 112 first paragraph. Applicants submit the term “stable at temperatures above 260°C” is fully supported in the application as filed and/or the provisional application. In addition, this temperature is known to the skilled artisan as the temperature of the bottles in the bottle forming mold and is therefore within the scope of the skilled artisan given the specification and the compositions disclosed in the present Application. The skilled artisan knows the temperature achieved in the manufacturing process of bottles (the process in which the present invention is used) is about 260°C (Range from 232°C to 288°C) as such the present invention must be able to withstand those temperatures.

Claims 1-2, 11-12, 14 and 16 are rejected under 35 U.S.C. § 103

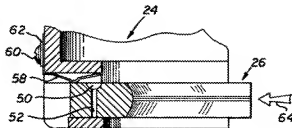
The Action rejects claims 1-2, 11-12, 14 and 16 under 35 U.S.C. § 102(b) as being unpatentable over Dorey, et al. (GB 2126211 hereafter “Dorey”) in view of Denney et al. (U.S Patent No. Re.

34,953 hereafter “Denney”) and even further in view of Recker et al. (U.S Patent No. 6,523,768 hereafter “Recker”). Applicant respectfully submits that claims 1-2, 11-12, 14 and 16 are not obvious over the cited art and are, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

The combination of Dorey, Denney and Recker fail to establish a prima facie case of obviousness, as the combination fails to teach or suggest all the claim limitations and there is no suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed the proposed modification.

In order to establish a prima facie case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed, (2) there must be a reasonable expectation of success, and (3) the prior art or combined references must teach or suggest all the claim limitations. MPEP § 2143; In re Vacek, 947 F.2d 488 (Fed. Cir. 1991). “The prior art must suggest the desirability of the claimed invention.” MPEP § 2143.01. Both the invention and the prior art references must be considered as a whole. MPEP § 2141.02.

Neither Dorey nor Denney teach a wedge shaped profile from the front edge to the rear edge adapted to frictionally fit a corresponding wedge shaped semi-circular insert. As stated in the Office Action, Dorey clearly does not disclose a wedge shaped profile. Similarly, Denney fails to disclose a wedge shaped profile. Denney discloses a takeout jaw with a semi-circular base having a wall having front and rear edges; a semi-circular shelf perpendicular to said wall, forming a pocket with said base; a top parallel to said base extending from said wall towards said front edge of said base; a yoke perpendicular to said top and extending therefrom; and a spring clip attached to the outside of said wall and extending through an opening in said wall formed by cut-outs in said wall, said shelf and said base. (See claim 1 of Denney). It is clear from the disclosure of Denny that the pocket is parallel and **NOT** wedge shaped. Specifically, Figures 4 and 7 show the parallel lines of the insert and the parallel lines of the pocket. Figure 7 of Denny is provided below.



The combination of Dorey and Denney provide nothing more than a parallel pocket, a parallel insert and a metal spring clip (element 58 in figure 7 above) that fits in a depression to retain immovably the insert within the pocket. The combination teaches the use of dissimilar materials having different coefficients of linear thermal expansion and at the high temperatures of the process, result in different expansion. The present invention does not use a metal clip.

The Action attempts to supply the missing element by the addition of a rotor assembly used to pulverize or grind scrap wood as disclosed in Recker. However, the combination still fails to teach or suggest all the claim limitations. Recker discloses a rotor assembly for comminuting [i.e., to reduce to minute particles, pulverize; to triturate; to grind] scrap wood and other like material using a rotor drum that include a drive shaft and at least one radially projecting tool supporting member with a tool assembly receiving pocket. The design of Recker is fundamentally different than the present invention and would not function as the present invention. **Recker includes an opening that is larger at the back and smaller at the front.** As a result of this design the insert **MUST** be a multi-piece design to allow the insert to fit through the smaller opening and still be secured in the larger back area. Therefore, the design of Recker is **totally** different from the present invention and would not function in conjunction with the present invention.

Second, there is no motivation to combine the reference teachings as proposed since such a combination would render the combination unsatisfactory for its intended purpose.

In addition, MPEP Section 2143.01(V) states that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Likewise, MPEP Section 2143.01 (VI) states “[i]f the proposed modification or combination of the prior art would change the principle of

operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

In addition, with a combination that is unsatisfactory for its intended purpose there can be no expectation of success. The combination of Recker would produce a proposed modification would renders the prior art invention being modified unsatisfactory for its intended purpose. It would be unsatisfactory and inoperable to use a multiple piece insert with a metal screw to retain the insert in the present invention. Furthermore, there still must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed. Applicant submits that there is no such motivation for the combination of Dorey **with** Denney **and** Recker.

The combination of Dorey **with** Denney **and** Recker still fails to provide any motivation in the prior art to modify the reference or to combine reference teachings as proposed. Specifically, Recker is not analogous prior art. Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole. LOGICALLY, the skilled artisan in the field of takeout holders for glass bottles would NOT look to a rotor assembly used to pulverize wood (Recker).

The combination of Dorey and Denney and Recker does not fulfill the requirements of 35 U.S.C. § 103(a). The combination does not provide each and every element of the present invention and would not work as the present invention. As a result, the Applicant respectfully submits that the claims as amended, are not obvious over the cited art and, therefore, respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claim 3 is rejected under 35 U.S.C. § 103

The Action rejects claim 3 under 35 U.S.C. § 103 as being unpatentable over Dorey in view of Denney, further in view of Recker and still further in view of Lloyd et al. (US 5,741,343). Applicant respectfully submits that claim 3 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, the combination of Dorey and Denney and Recker fail to establish a prima facie case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Lloyd merely teaches stacker bar pads and as such its addition does not cure this deficiency.

The combination of Dorey **and** Denney **and** Recker **and** Lloyd does not fulfill the requirements of 35 U.S.C. § 103(a). The combination does not provide each and every element of the present invention and would not work as the present invention. Lloyd teaches against the use of plastics because they cannot withstand the temperatures **AND** Dorey teaches against the use of ceramic materials because they are brittle and easily chipped. The skilled artisan would not have looked to the combination of Dorey **and** Denney **and** Recker **and** Lloyd to address the problem of the present invention. Furthermore, given the teachings of Dorey **and** Denney **and** Recker **and** Lloyd the skilled artisan would have no indication that the combination would work. As a result, the Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claim 4 is rejected under 35 U.S.C. § 103

The Action rejects claim 4 under 35 U.S.C. § 103 as being unpatentable over Dorey in view of Denney, further in view of Recker still further in view of Lloyd et al. and even further in view of Oberlin (U.S Patent 3,473,938). Applicant respectfully submits that claim 4 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, the combination of Dorey **and** Denney **and** Recker **and** Lloyd fail to establish a prima facie case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. The addition of Oberlin does not cure this deficiency.

Furthermore, there still must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed. Applicant submits that there is no such motivation for the combination of Dorey **and** Denney **and** Recker **and** Lloyd **and** Oberlin.

The combination of Dorey **and** Denney **and** Recker **and** Lloyd **and** Oberlin does not fulfill the requirements of 35 U.S.C. § 103(a). The combination does not provide each and every element of the present invention and would not work as the present invention. As a result, the Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claims 5 is rejected under 35 U.S.C. § 103

The Action rejects claims 5 under 35 U.S.C. § 103 as being unpatentable over Dorey in view of Denney, further in view of Recker still further in view of Lloyd et al. and even further in view of Nishikawa et al. (U.S Patent No. 4,900,807). Applicant respectfully submits that claim 5 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, the combination of Dorey **and** Denney **and** Recker **and** Lloyd fail to establish a prima facie case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Nishikawa merely discloses polymers obtained by polymerizing a nitrile-terminated Schiff compound alone or together with other monomers and as such its addition does not cure this deficiency.

As a result, Applicant respectfully submits that the claim as amended, is not obvious over Dorey **and** Denney **and** Recker **and** Lloyd **and** Nishikawa and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claim 13 is rejected under 35 U.S.C. § 103

The Action rejects claim 13 under 35 U.S.C. § 103 as being unpatentable over Dorey in view of Denney, further in view of Recker still further in view of Mohler et al. (U.S. 6,805,832). Applicant respectfully submits that claim 13 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, the combination of Dorey **and** Denney **and** Recker fail to establish a prima facie case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. The addition of a thermite torch cutting nozzle by Mohler does not cure this deficiency. Mohler merely discloses a thermite torch cutting nozzle that is fabricated from a material selected from the group consisting of mineral/phenolic and high temperature plastic. At the very most Mohler discloses the "...mineral/phenolic. High temperature plastics, such as glass-filled polyetheretherketone, may also be used for such nozzles" (see column 4, lines 23-25; emphasis added). However, Mohler provides no guidance to any parameters compositions or specifics other than the use of the term mineral/phenolic and glass-filled polyetheretherketone. The material must be suitable for the desired purpose, which includes limiting the transfer of materials from the holder/insert to the bottle, reducing marring of the bottle.

As a result, Applicant respectfully submits that the claim as amended, is not obvious over Dorey **and** Denney **and** Recker **and** Mohler and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claims 17-19 are rejected under 35 U.S.C. § 103

The Action rejects claims 17-19 under 35 U.S.C. § 103 as being unpatentable over Denney in view of Recker and further in view of Kume et al. (JP 04160065 A). Applicant respectfully submits that claims 17-19 are not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, the combination of Denney **and** Recker fail to establish a prima facie case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. The addition of Kume fails to cure this deficiency.

The combination of Denney **and** Recker **and** Kume fail to teach a **wedge shaped profile** from the front edge to the rear edge **adapted** to frictionally fit a corresponding **wedge shaped semi-circular insert**. As such the combination of Denney **and** Recker **and** Kume CANNOT teach a wedge shaped profile and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Applicant respectfully submits that the claims as amended, are not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Claim 20 is rejected under 35 U.S.C. § 103

The Action rejects claims 20 is rejected under 35 U.S.C. § 103 as being unpatentable over Denney in view of Recker and further in view of Kume and even further in view of Filges et al. (U.S Patent 6,517,597). Applicant respectfully submits that claim 20 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, Denney **and** Recker **and** Kume do not **identically disclose every element** of the claimed invention. Specifically, the combination of Denney **and** Recker **and** Kume does not teach a takeout holder having a **wedge shaped profile** from the front edge to the rear edge **adapted** to frictionally fit a corresponding **wedge shaped semi-circular insert**. The addition of a glaze by Filges does not cure this deficiency.

Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

Conclusion

In light of the remarks and arguments presented above, Applicant respectfully submits that the claims in the present Application are in condition for allowance. Favorable consideration and allowance of the pending claims are therefore respectfully requested. If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

Dated: June 18, 2008.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Chainey Singleton', is written over a horizontal line.

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